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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/982,419	12/30/2010	Charles McCoy	201003475.02	8332

51518 7590 05/01/2017
MAYER & WILLIAMS PC
928 Mountain Avenue
Second Floor
Mountainside, NJ 07092

EXAMINER

HALEY, JOSEPH R

ART UNIT	PAPER NUMBER
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2695

NOTIFICATION DATE	DELIVERY MODE
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05/01/2017

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHARLES MCCOY, LING JUN WONG, and
TRUE XIONG

Appeal 2017-002394
Application 12/982,419
Technology Center 2600

Before LARRY J. HUME, LINZY T. McCARTNEY, and
MATTHEW J. McNEILL, *Administrative Patent Judges*.

McCARTNEY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a rejection of claims
1–25. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

STATEMENT OF THE CASE

The present patent application concerns “[s]ystems and methods for creating and employing software to handle the playback of media . . . in browsers that, in addition to or instead of playing the media in the browser, may use the second display protocols to instruct a separate device to play the media.” Spec., Abstract. Claims 1, 13, 21, and 25 are independent. Claim 1 illustrates the claimed subject matter:

1. A method of playing a content item on a content playback device using a second display, comprising:
 - i. establishing a browsing session between the second display and a source of content;
 - ii. instantiating a plug-in or helper application on the second display;
 - iii. playing back at least a portion of a content item in the plug-in or helper application on the second display, the playing back occurring by, in the second display, arranging presentation of an authentication credential of a content playback device to the source of content; and
 - iv. causing the content item to playback in the content playback device, wherein the causing includes using the second display to request the content item, the request using an authentication credential of the content playback device.

REJECTIONS

Claims 1–9 and 11–25 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Wang et al. (US 7,886,318 B2; Feb. 8, 2011) and Pliska et al. (US 2010/0279766 A1; Nov. 4, 2010).

Claim 10 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Wang, Pliska, and Ma et al. (US 2005/0278737 A1; Dec. 15, 2005).

ANALYSIS

Appellants contend the Examiner has not provided sufficient reason to combine the teachings of the cited art in the fashion recited in the independent claims. *See* App. Br. 9–10, 13–15; Reply Br. 3. In particular, Appellants assert “the entirety of the reasoning supplied by the Examiner is that a preview functionality would work in the apparatus of Wang and that the same would provide predictable results.” App. Br. 10. Appellants argue “there must be . . . articulated reasoning with some rational underpinning to support the legal conclusion of obvious, and such is lacking here.” *Id.*

We find Appellants’ argument persuasive. With respect to independent claims 1, 13, 21, and 25, the Examiner found it would have been obvious to combine Wang’s and Pliska’s teachings “because the preview of [Pliska] . . . would work equally well in the apparatus of Wang . . . as it does separately and would provide predictable results.” Final Act. 3–4. The Examiner also found Wang and Pliska “are from a similar problem solving area and have many common features” and that combining their respective teachings “would be well within the skill of someone in the art,” “would not change the principle [of] operation of Wang[,] and would not have any negative or unpredictable effect.” Ans. 3.

As an initial matter, these statements lack any supporting reasoning or evidence. *See In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”). But even if the Examiner had provided adequate supporting reasoning or evidence for these statements, at best these statements establish that one of ordinary skill

in the art *could have* combined the cited art. But the mere fact that one of ordinary skill in the art could have combined the prior art does not establish that one of ordinary skill in the art *would have had a reason to do so*. See *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (explaining that an obviousness analysis must “determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue”); *Malico, Inc. v. Cooler Master USA Inc.*, 594 F. App’x 621, 628 (Fed. Cir. 2014) (non-precedential) (explaining that the ability to perform a particular action “without any reason to do so does not establish obviousness”).

On the record before us, we agree with Appellants that the Examiner failed to provide an adequate reason to combine the cited art in the proposed manner. Accordingly, we do not sustain the Examiner’s rejections of the pending claims. We express no opinion on the Examiner’s other findings concerning the prior art.

DECISION

We reverse the rejections of claims 1–25.

REVERSED